

**REMARKS/ARGUMENTS**

This amendment responds to the Office Action dated April 24, 2008, in which the Examiner rejected claim 8 under 35 U.S.C. § 102(e) and rejected claims 1-6 and 9 under 35 U.S.C. § 103.

As indicated above, claims 1, 4 and 8-9 have been amended in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability.

Claims 1 and 8 claim a recording system for recording and/or reserving a program. The recording system comprises a request accepting portion/means, a local storage/means, connection portion/means, determining portion/means and issuing portion/means. The accepting portion/means accepts a request to record and/or reserve a program. The local storage portion/means records the program. The connection portion/means connects, via a wide area network with an external device which is external to the recording system. The determination portion/means determines whether it is possible to record the program requested on the local storage portion/means. The issue portion/means issues a recording substitution request to the external device via the wide area network to record the program.

By (a) having the recording system connected with an external device which is external to the recording system and connected via a wide area network and (b) having an issue portion/means which issues a recording substitution request to the external device to record the program when it is not possible to record the program on the local storage portion/means, the claimed invention provides a recording system which allows a program to be recorded even when a failure in the local storage prevents the program from being recorded. The prior art does not show, teach or suggest the invention as claimed in claim 8.

Claims 4 and 9 claim a recording substitution system for substitutionally recording a program. The recording substitution system includes a connection portion/means for connecting via a wide area network with external devices. A receiving portion/means receives a program. A storage portion/means records the program. A recording substitution portion responds to reception of a recording substitution request from one of the external devices via the connection portion and receives and records a program corresponding to the request in the storage portion/means. The recording substitution portion either replaces advertising content with new advertising content received from another external device, or inserts additional advertising content from the other external device into the recorded program.

By having a connection portion (a) which connects via a wide area network with external devices and (b) which responds to a recording substitution request from at least one of the external devices as claimed in claims 4 and 9, the claimed invention provides a recording substitution system which will record a program when a user's recording medium has insufficient capacity or a recording failure. The prior art does not show, teach or suggest the invention as claimed in claims 4 and 9.

Claim 8 was rejected under 35 U.S.C. § 102(e) as being anticipated by *Chihara* (U.S. Patent No. 6, 678,462).

*Chihara* appears to disclose a home gateway 1 responsible for properly controlling an analog video tape recorder 2, digital video tape recorder 3, and television set 4 through a home bus 5 (Col. 5, lines 10-12). At step S11, CPU 21 examines the type of electronic devices connected to the home gateway 1 via the home bus 5 and determines the number thereof (Col. 6, lines 5-7). In step S14, CPU 21 selects an electronic device capable of recording the file (data) having that size. Then the routine goes to step S15 in which it is determined whether the

selected electronic device has enough recording capacity. If the remaining recording capacity is not enough, the routine goes to step S16 and the CPU 21 determines whether there is another electronic device which has not yet been checked (Col. 6, lines 14-19). If it is determined after check all electronic devices that there is no electronic device that has enough recording capacity, then the routine goes to step S18 and the CPU 21 concludes that the recording is impossible (Col. 6, lines 24-27).

Thus, *Chihara* only discloses a home gateway 1 connected to a home bus 5 which checks the devices connected to the home bus for sufficient capacity. Nothing in *Chihara* shows, teaches or suggests a connection portion configured to connect via a wide area network with an external storage device which is external to the recording system as claimed in claim 8. Rather, *Chihara* teaches away from the claimed invention and only connects the home gateway 1 to the local recording devices 3, 2.

Additionally, *Chihara* merely discloses that upon checking the devices, if capacity is insufficient, concluding that recording is impossible. However, as claimed in claim 8, when a determination is made that the local storage portion contains insufficient space, the issue portion automatically issues a request to an external storage device to record the program. However, *Chihara* teaches away from the claimed invention and merely concludes that recording is impossible.

Since nothing in *Chihara* shows, teaches or suggests (a) a recording system connecting with an external device, which is external to the recording system, via a wide area network and (b) an issue portion automatically issuing a request to the external device via the wide area network to record the program as claimed in claim 8, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 102(e).

Claim 8 was rejected under 35 U.S.C. § 102(e) as being anticipated by *Kuroda* (U.S. Patent No. 6,311,011).

*Kuroda* appears to disclose a video recorder/player comprising a program information receiver 101, tuner 102, temporary storage device 103, temporary recording controller 104, storage device 105, output module 106 and data bus 107 (Col. 4, lines 6-11). When the amount of programs recorded to the temporary storage device 103 overflows, the temporary recording controller 104 deletes the oldest contents from the temporary storage device 103. The storage device 104 stores content signals according to user direction (Col. 4, lines 32-39). When the viewer gives the video recorder/player an intentional direction to record a television program, the program is recorded in the storage device 105. The program recorded in the storage device 105 is held until another intentional direction to delete the program is given by the viewer. A program recorded to the temporary storage device 103 is automatically deleted after a while if an intentional direction to save the program is not given (Col. 4, lines 44-53). If remaining capacity is insufficient at step S107, a dialogue warns the storage device selected does not have sufficient capacity for recording the contents and allows a viewer a choice to select another storage device (Col. 5, lines 50-65). FIG. 22 shows an electronic program guide (EPG) screen where the viewer is selecting one of the storage devices managed by the EPG displaying device (Col. 11, lines 27-29).

Thus, *Kuroda* similarly discloses a video recording/player connected to two local storage devices 103, 105 through a local bus 107. Nothing in *Kuroda* shows, teaches or suggests a connection portion configured to connect via a wide area network with an external storage device external to the recording system as claimed in claim 8. Rather, *Kuroda* only discloses connecting to two local storage devices 105, 103 via the local data bus 107.

Furthermore, *Kuroda* merely discloses Col. 5, lines 60-67 and FIG. 22, a user selecting devices connected to the video recorder/player. Nothing in *Kuroda* shows, teaches or suggests automatically issuing a recording substitution request to an external storage device via the wide area network as claimed in claim 8. Rather, *Kuroda* only discloses selecting a device connected to the video recorder/player.

Finally, *Kuroda* discloses asking a viewer to select another storage device when the selected device has insufficient capacity. Nothing in *Kuroda* shows, teaches or suggests automatically issuing a recording substitution request to an external storage device via a wide area network as claimed in claim 8. Rather, *Kuroda* only discloses asking a user to select another device connected to the video recorder/player.

Since nothing in *Kuroda* shows, teaches or suggests (a) a connection portion configured to connect via wide area network with an external storage device which is external to the recording system and (b) an issue portion configured to automatically issue a recording substitution request to the external storage device via the wide area network to record a program as claimed in claim 8, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 102(e).

Claims 1-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Zigmond, et al.* (U.S. Patent No. 6,698,020).

As discussed above, *Kuroda* merely discloses a video recorder/player connected to storage devices 103, 105 through a local data bus. Nothing in *Kuroda* shows, teaches or suggests a connection means for connecting via a wide area network with external devices as claimed in claims 1, 4 and 9. Rather, *Kuroda* only discloses connecting to local storage devices 103, 105 through a local data bus.

Additionally, *Kuroda* merely discloses that if insufficient capacity is available, asking a viewer to select another storage device (Col. 5, lines 60-67, FIG. 22). Nothing in *Kuroda* shows, teaches or suggests issuing a recording substitution request to an external device via the wide area network as claimed in claim 1. Rather, *Kuroda* only discloses asking a viewer to select another local device on the local data bus 107.

Also, since *Kuroda* only discloses asking a user to select another storage device (Col. 5, lines 60-67, FIG. 22) nothing in *Kuroda* shows, teaches or suggests a recording substitution means/portions which respond to reception of recording substitution request from one of the external devices via the wide area network as claimed in claims 4 and 9. Rather, *Kuroda* only discloses asking a user to select another local storage device.

Finally, nothing in *Kuroda* shows, teaches or suggests inserting advertising content with new advertising content received from another external device or inserting additional advertising content from the other external device into the recorded program as claimed in claims 4 and 9.

*Zigmond, et al.* appears to disclose that during display of a video programming feed, a selected advertisement is displayed at an appropriate time based on a triggering event (Col. 4, lines 36-52). The system may be used to select appropriate advertisements based on whether the video programming feed is watched as a broadcast or replayed from recorded media. Advertisers can thus update time-sensitive advertisements. Furthermore, originally recorded advertisements can be replaced with effectively targeted ads (Col. 14, lines 1-12).

Thus, *Zigmond, et al.* merely discloses that based upon a triggering event and program feed from a recording media during replay (Col. 4, lines 36-52), an appropriate advertisement is inserted into the displayed program. Nothing in *Zigmond, et al.* shows, teaches or suggests inserting advertising information in a recorded program stored in a storage means in addition to

originally commercial information or substituted for the original commercial information included in the recorded program as claimed in claims 4 and 9. Rather, *Zigmond, et al.* only discloses that during the program feed or replay thereof, when a triggering event occurs, appropriate advertising information is displayed.

A combination of *Kuroda* and *Zigmond, et al.* would merely suggest that a user is prompted when a storage device contains insufficient capacity as taught by *Kuroda* and that during program feed or replay, when a triggering event occurs, advertisement is selected and displayed as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests (a) a connection portion figured to connect via a wide area network with an external device(s) as claimed in claims 1, 4 and 9, (b) issuing a recording substitution request to an external device via the wide area network to record a program as claimed in claim 1, (c) receiving a record substitution request from an external device via the wide area network as claimed in claims 4 and 9 and (d) replacing or inserting advertising content into a recorded program as claimed in claims 4 and 9. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 1, 4 and 9 under 35 U.S.C. § 103.

Claims 2-3 and 5-6 depend from claims 1 and 4 and recite additional features. Applicants respectfully submit that claims 2-3 and 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Zigmond, et al.*, at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the objection to claims 2-3 and 5-6 under 35 U.S.C. § 103.

New claims 10-11 have been added and recite additional features. Applicants respectfully submit that these claims are also in condition for allowance.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.



**CONCLUSION**

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 05-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

Date: July 23, 2008

By: 

Ellen Marcie Emas  
Reg. No. 32,131  
Tel. (212) 588-0800